

## II. REMARKS

This response is made to the Office Action mailed March 14, 2005.

In the subject Office Action: (1) Claims 17 and 18 were rejected as indefinite under 35 U.S.C. § 112, second paragraph; (2) Claims 1-11, 13-14 and 19 were rejected under 35 USC § 102(b) as anticipated by U.S. Patent No. 5,387,389 (CATALANOTTI et al; (3) Claims 1-7, 9-11 and 13-20 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,722,011 (BACON); and, (4) Claim 12 was rejected as obvious over the combination of BACON and/or CATALANOTTI et al.

By the present amendment, applicant has cancelled Claim 7, without prejudice, and has amended Claims 1 and 13 and presented arguments in support of patentability and explaining why the current rejections are incorrect. Entry of this amendment and reconsideration of this application are respectfully requested.

Independent Claim 1 has been amended for purposes of clarity to confirm what is disclosed in the specification and drawings, namely, that the solid portion of the elongated body is located at the tool driving end of the tool and has been further amended to recite that the slots very in width lengthwise along the tool body.. Independent Claim 13 has been amended to correct an inadvertent typographical error and this claim now reads that one end of the annular recess is spaced apart from the “contact arm free ends” as opposed to “contact free arms”. Such amendments are made for the purposes of clarity.

Applicant first respectfully traverses the rejection of claims 17-18 as indefinite. The Examiner has misunderstood the claim language of these two claims. The length, namely that of the annular recess is a length that occurs on the exterior surface of the tool, and its is not a varying length. The first preselected length mentioned in Claim 13 is the entire length of the tool, shown as **LR** in FIG. 6 and that is explained in Paragraphs 0048 and 0049. The second preselected length recited in Claim 13 is the length of the internal cavity of the tool, shown as **LR** in FIG. 6. This length is also explained in Paragraphs 0048 and 0049 of the specification. As common sense would dictate, the length of the internal cavity, **L** must be less than the overall length **LR** of the tool for there to be a driving end as called for in Claim 13.

The “third preselected length” recited in Claims 17 and 18 is the length of the annular recess, which as explained in Paragraph 0050, is formed in the exterior surface of the tool and it assists in defining the thicknesses of the arms of the tool. The length of this annular recess is recited in Claim 17 as being less than the “first preselected length”, which is the overall length of the tool and the relationship with which is shown in drawing FIGS. 4 and 7-9B. One skilled in the art

would not find Claim 17 and the expressed relationship between the first and third preselected lengths indefinite.

In Claim 18, the third preselected length, the length of the annular recess is recited as being less than the second preselected length, which is the length of the internal cavity, which is a length that is different than that of the first preselected length, the overall length of the tool. This difference in length is clearly shown in FIG. 9B. It is also respectfully submitted that one skilled in the art would not find the relationships recited in Claim 18 between the third and second preselected lengths indefinite. Accordingly, the withdrawal of the rejection of claims 17 and 18 under Section 112 is respectfully requested.

Turning now to the rejections based upon prior art, it is respectfully submitted that CATALANOTTI et al. does not anticipate the subject matter of independent Claim 1 and dependent Claims 2-11 or independent Claim 13 and dependent claims 14 and 19 for it does not include, either expressly or inherently, each and every claim element recited by applicant within the four corners of it. CATALANOTTI et al. describes an injection molding tool that is held within a plurality of mold blocks 32, 34 and 36. In fact, the tool is fixed in place within the mold blocks. The tool is in the form of a hollow cylinder with a plurality of arms and the tool has a central opening 45 that extends from one end (ridge 43) to the other open end, i.e., completely through the tool. (Col. 5, lines 45-49.) In fact the tool needs this central opening in order to accommodate a separate mandrel 48 that is inserted into the tool in order to eject a molded part and in order to expand the free ends of the arms of the tool.

As such, CATALANOTTI et al. does not include the subject matter of independent Claim 1 of a difference in the first and second preselected lengths as defining a “solid portion of said body” that further abuts a hollow cavity of the tool. Furthermore, CATALANOTTI et al. does not have a “substantially solid driving end with a reaction surface for applying a ring application driving force” may be applied as called for in Claim 13. Nor does it have “a solid portion of said body at said tool driving end” as called for in independent Claim 1. Rather, and contrary to the construction claimed in independent Claims 1 and 13, CATALANOTTI et al. has a hollow passage that extends completely through the tool. In having its central opening 45 extend completely through the tool, CATALANOTTI does not have an internal cavity with a length that is less than the overall length of the tool, i.e. having a second preselected length that is less than a first preselected length.

Nor does CATALANOTTI et al. have slots formed in its sidewalls that vary in width lengthwise of the tool body as called for in dependent Claims 7 and 8, or has a hollow cavity that ends before the rear end of the tool but rearwardly of an annular recess on the exterior of the tool as

called for in dependent Claim 9.

It should be clear that CATALANOTTI is incapable of serving as an anticipatory reference under 25 USC § 102 against applicant's claims. Accordingly, the withdrawal of the Section 102 rejections of Claims 1-11, 13-14 and 19 based upon CATALANOTTI et al. and the allowance of those claims is respectfully requested.

Claims 1-7, 9-11 and 13-20 stand rejected under 35 U.S.C. § 102(b) as anticipated by BACON. BACON describes a C-Clip installation tool that has a plastic solid body with a narrowed installation end with four ring-supporting arms formed therewith. Each arm has a notch at its front (FIG. 3B) to define a lip of a ridge 350 against which a C-clip is placed. There is an abrupt transition at the point where the plastic body meets the ring-supporting arms and the ring supporting arms have a constant thickness throughout their length, with only the ridge providing any change in their profile. The ring-supporting arms, at their free ends, do not extend either radially inwardly or outwardly. They do not vary in their size lengthwise along the length of the tool body, thereby confirming what is shown in the drawings, that the slots formed in the tool that define the ring-supporting arms of BACON are uniform in their width.

Independent Claim 1 has been amended for clarity and has been amended to recite that the slots of the installation tool vary in width lengthwise of the tool body. Such a feature is not shown in BACON. Indeed, looking at the end view of FIG. 3C, the slots are shown as uniform. Such language is not present, expressly or inherently in BACON. Nor, as admitted by the Examiner in the Office Action, does BACON contain the subject matter of dependent Claim 8, that the slots have a smaller width at the installation end of the tool. Still further, it should be noted that the subject matter of dependent Claim 11 is not present in BACON, for no angled transition surface is shown at the location where the arms extend from the solid body portion. Instead, BACON utilizes a hard flat transition, thereby creating an area where high stress concentrations may occur during use of the tool.

Still further, BACON does not contain the subject matter of dependent Claims 2 and 5 for BACON does not show contact arms bent radially outwardly so that the tool installation end has a diameter larger than that of the tool driving end. Rather, BACON shows an installation end that has a diameter that is less than its rear end in order to define a "lip" upon which to place the C-Clip. As such, BACON cannot anticipate dependent Claim 2. Also, due to the notch-like nature of the "lip", BACON cannot anticipate the claim language of dependent Claim 5 which recites that the thickness of the contact arms "increases at the enlarged ends thereof. BACON has a reduced thickness end in order to support the C-Clip, and therefore has a construction that is opposite that

claimed.

As for the rejection of Claims 13-20 based upon BACON, applicants note that the claims contain structure not present or suggested in BACON or the other art made of record. Independent Claim 11 calls for the tool to have a solid "metal body", whereas BACON uses a plastic body (Col. 5, lines 31-36). Claim 11 also calls for the contact arms of it to terminate in free ends and the free ends including ring-contacting surfaces thereon. The ring-supporting surfaces of BACON are spaced rearwardly of the free ends of the BACON tool arms. Still further, BACON does not show an contact arm free ends that are bent inwardly or outwardly as called for in dependent Claim 15 and 16 because the tool of BACON uses a lip in the form of a notch, rather than a flat pushing surface as shown in the disclosure of the subject application. Lastly, dependent Clai8m 19 calls for the solid end to be tapered to meet the exterior annular recess, and BACON has no such taper, but rather has an abrupt narrowed portion with a flat face. Accordingly, the withdrawal of the rejection of claims 13-20 based upon BACON and the allowance thereof is respectfully requested.

As for the obviousness rejection of claim 12, it is not a mere substitution of material given the application and the teaching of BACON to use plastic. CATALANOTTI et al. is not concerned with pushing a work element, such as a retaining ring into a bore or onto a shaft, but rather is directed toward ejecting a molded part held by the end of its cavity tool. This rejection should also be withdrawn.

It is respectfully submitted that the claims now patentably define over the prior art relied upon by the Examiner.

Respectfully submitted,

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